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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	08/793,416
Filing Date	10/23/1997
First Named Inventor	Hare, Thomas John
Art Unit	3641
Examiner Name	Behrend
Attorney Docket Number	ITW-12287

### ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC  <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="text"/> Remarks		

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Welsh & Flaxman LLC		
Signature			
Printed name	Howard N. Flaxman		
Date	10/25/2004	Reg. No.	34,595

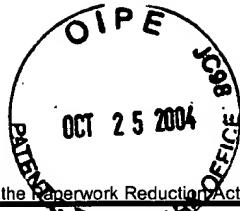
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# FEE TRANSMITTAL

## for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 340.00)

## Complete if Known

Application Number	08/793,416
Filing Date	10/23/1997
First Named Inventor	Hare, Thomas John
Examiner Name	Behrend
Art Unit	3641
Attorney Docket No.	ITW-12287

## METHOD OF PAYMENT (check all that apply)

 Check  Credit card  Money Order  Other  None

 Deposit Account:

Deposit Account Number **01-2221**  
 Deposit Account Name **Welsh & Flaxman LLC**

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below  Credit any overpayments  
 Charge any additional fee(s) or any underpayment of fee(s)  
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 790	2001 395	Utility filing fee	
1002 350	2002 175	Design filing fee	
1003 550	2003 275	Plant filing fee	
1004 790	2004 395	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1) (\$ 0)</b>			

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20**	=	
			- 3**	=	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 88	2201 44	Independent claims in excess of 3
1203 300	2203 150	Multiple dependent claim, if not paid
1204 88	2204 44	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent
<b>SUBTOTAL (2) (\$ 0)</b>		

\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 430	2252 215	Extension for reply within second month	
1253 980	2253 490	Extension for reply within third month	
1254 1,530	2254 765	Extension for reply within fourth month	
1255 2,080	2255 1,040	Extension for reply within fifth month	
1401 340	2401 170	Notice of Appeal	
1402 340	2402 170	Filing a brief in support of an appeal	
1403 300	2403 150	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,370	2453 685	Petition to revive - unintentional	
1501 1,370	2501 685	Utility issue fee (or reissue)	
1502 490	2502 245	Design issue fee	
1503 660	2503 330	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 790	2809 395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 790	2810 395	For each additional invention to be examined (37 CFR 1.129(b))	
1801 790	2801 395	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify) _____			
*Reduced by Basic Filing Fee Paid		<b>SUBTOTAL (3) (\$ 340.00)</b>	

(Complete if applicable)

Name (Print/Type)	Howard N. Flaxman	Registration No. (Attorney/Agent)	34,595	Telephone	703 920 1122
Signature			Date	10/25/2004	

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: John Thomas Hare

Group Art Unit: 3641

Serial No.: 08/793,416

Examiner: Behrend

Filed : 10/23/1997

Title : MOULDED RADIATION SHIELD

**APPEAL BRIEF**

Commissioner of Patents  
and Trademarks  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

**REAL PARTY IN INTEREST**

Illinois Tool Works, Inc. is the real party in interest in the above referenced patent application.

**RELATED APPEALS AND INTERFERENCES**

Neither Appellants' representative, Appellants nor Appellants' Assignee are aware of any related appeals and/or interferences affected by or having a bearing on the Board's decision in the pending appeal.

## STATUS OF CLAIMS

Claims 20-26 are currently pending. Claims 30-38 have been withdrawn from consideration.

Claims 20-26 stand finally rejected. Appellants accordingly appeal the Examiner's final rejection of claims 20-26, which is as follows:

1. Claims 20-26 stand rejected under 35 USC § 103(a) as being unpatentable over any of U.S. Patent No. 3,515,625 to Sedlak et al. (Sedlak) or U.S. Patent No. 3,864,124 to Breton et al. (Breton) or GB Patent No. 954,595 to Weinberger (Weinberger) in view of any of U.S. Patent No. 2,312,920 to Lubow (Lubow), U.S. Patent No. 2,286,877 to Sternlicht (Sternlicht), U.S. Patent No. 3,311,933 to Allen (Allen), GB Patent No. 856,747 to Futo et al. (Futo), or U.S. Patent No. 2,063,329 to Morrison (Morrison).
2. Claims 20-26 stand rejected under 35 USC § 103(a) as being unpatentable over Sedlak or Breton or Weinberger in view of Lubow, Sternlicht, Allen, Futo or Morrison, and further in view of U.S. Patent No. 3,675,060 to Harrison (Harrison) and U.S. Patent No. 2,175,283 to Cote (Cote), U.S. Patent No. 4,748,060 to Fry et al. (Fry) or U.S. Patent No. 4,857,371 to McClintock (McClintock).
3. Claims 20-26 stand rejected under 35 USC § 103(a) as being unpatentable over any of Sedlak or Breton or Weinberger in view of Lubow, Sternlicht, Allen, Futo or Morrison, and further in view of U.S. Patent No. 2,497,543 to Frevel (Frevel), U.S. Patent No. 2,830,000 to Labino (Labino), Japanese Patent No. 59-52799 ("799 patent) or U.S. Patent No. 3,895,143 to Tarlow (Tarlow).
4. Claims 20-26 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

5. Claims 20-26 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.
6. Claims 20-26 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **STATUS OF AMENDMENTS**

No Amendments have been filed subsequent to the issuance of the Final Rejection. All amendments filed prior to the Final Rejection have been entered and considered.

#### **SUMMARY OF THE INVENTION**

In accordance with the present invention, a moulded shield is provided for a source of  $\gamma$ -rays. The shield defines a cavity for receiving the source. The shield includes a core layer of cured liquid silicone resin loaded with particulate  $\gamma$  radiation-shielding material. The core layer is adapted to surround the radiation source located in the cavity. The core layer is located between two outer layers of solid polymeric material. (Page 3, lines 9-13 of the Specification as originally filed)

The shield is used for fitting over ancillary equipment associated with nuclear power installations, such as, in the steam generating circuitry of nuclear power installations and the like, and to which access is required, for example, for routine maintenance or repairs. The presence of outer layers of solid polymeric material in the present shield ensures that the particulate radiation shielding material, such as lead powder, which is incorporated in the core layer, is separated from radiation emitting metal parts, thereby obviating the risks of electrolyte attack. The outer layers of the present

shield also enable the core layer to have a higher loading of the particulate material than would otherwise be possible while still retaining cohesiveness, tear strength and the ability of the moulded shield to support its own weight. This enables a desired layer of attenuation to be achieved at a reduced level of wall thickness in the shield. (Page 4, line 10, through Page 5, line 1, of the Specification as originally filed)

By carefully designing the shape of the moulded shield, shine, that is, the leakage of radiation, can be substantially eliminated or at least significantly reduced as compared with the conventional use of shielding devices from an *ad hoc* assemblage of sheets or tiles. Where the shield is designed for protecting pipes, the shield is formed in the shape of a tube with a longitudinal slit 4. Because the shield is made of a resilient material, the slit 4 may be opened so that it can be pushed over a length of pipe and then closed over the pipe. (Page 5, lines 2-6, and Page 6, lines 18-22, of the Specification as originally filed)

The slit 4 is preferably formed such that when the tube is closed over the pipe, the protection provided by the tube is unbroken. For example, the slit extends from the inner face to the outer face of the tube at an angle to the radius. (Page 7, lines 2-5, of the Specification as originally filed)

As briefly mentioned above, the shield comprises a core layer 30 of cured silicone resin loaded with particulate radiation shielding material adapted to surround the radiation source located in the cavity. The core layer 30 is located between two layers 40 of unfilled solid polymeric material. The core layer 30 is actually encapsulated within the solid polymeric material which, as shown, completely surrounds the core 30. (Page 8, lines 8-22, of the Specification as originally filed)

## ISSUES

1. Whether claims 20-26 are unpatentable under 35 USC § 103(a) based upon the disclosures of Sedlak or Breton or Weinberger in view of Lubow, Sternlicht, Allen, Futo or Morrison.
2. Whether claims 20-26 are unpatentable under 35 USC § 103(a) based upon the disclosures of Sedlak or Breton or Weinberger in view of Lubow, Sternlicht, Allen, Futo or Morrison, and further in view of Harrison and any of Cote, Fry or McClintock.
3. Whether claims 20-26 are unpatentable under 35 USC § 103(a) based upon the disclosures of Sedlak or Breton or Weinberger in view of Lubow, Sternlicht, Allen, Futo or Morrison, and further in view of any of Frevel, Labino, the '799 patent or Tarlow.
4. Whether claims 20-26 are unpatentable under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.
5. Whether claims 20-26 are unpatentable under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.
6. Whether claims 20-26 are unpatentable under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

## GROUPING OF THE CLAIMS

All of the Claims stand or fall together.

## ARGUMENTS

### I. CLAIMS 20-26 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103(a) BASED UPON THE DISCLOSURE OF SEDLAK OR BRETON OR WEINBERGER IN VIEW OF LUBOW, STERNLICHT, ALLEN, FUTO OR MORRISON.

Claim 20 defines a moulded shield for a source of  $\gamma$ -rays. The moulded shield includes a cylindrical shield body having a cavity shaped and dimensioned to receive the source. The shield body is constructed in the form of a tube with an inner face and an outer face, and a longitudinal slit for fitting over a pipe so as to permit the passage of the source into the cavity. The slit extends from the inner face to the outer face at an oblique angle relative to the radius of the shield body and the slit is unsealed along its length to facilitate the passage of the source therethrough. The shield body further includes a core layer of cured liquid silicone resin loaded with particulate  $\gamma$ -radiation shielding material adapted to surround a radiation source located in the cavity. The core layer is located between the two outer layers of the solid polymeric material.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . . . This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a *prima facie* case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j). It has further been determined that "[w]here a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection."

See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407, n. 3 (CCPA 1970).

In addressing claim 20, the Examiner has agreed that none of the primary references, that is, Sedlak, Breton or Weinberger, disclose a shield having an obliquely oriented, unsealed slit in conjunction with a cylindrical shield body as claimed. In fact, these references merely disclose radiation shielding materials. Lubow, Sternlicht, Allen, Futo and Morrison have been cited as suggesting the obviousness of modifying Sedlak or Breton or Weinberger with an obliquely angled, unsealed slit in conjunction with a cylindrical shield body. However, these prior art references merely disclose various seams used in protective materials. They do not disclose the obviousness of applying the claimed slit to a cylindrical shield body having a core layer of liquid silicone resin loaded with particulate  $\gamma$ -radiation material. In addition, these references fail to even disclose an obliquely angled, unsealed slit as claimed.

The highly specific nature of the shield body material dictates that its construction is very distinct from prior radiation shields and it would, as such, not have been obvious based upon the

cited prior art to provide a cylindrical shield with an obliquely angled, unsealed slit as claimed. The present shield includes an obliquely angled, unsealed slit for a variety of reasons. The slit first provides enhanced protection from shine by preventing the direct emission of radiation therethrough. In addition, all materials expand and contract, and the angled, unsealed slit allows for the edges to ride upon each other without compromising the protection being offered by the shield.

Nothing in the prior art addresses these concerns as the cited prior art devices are structurally different from the claimed invention and, consequently, address very different and unrelated issues. For example, Morrison discloses a two-part shield having first and second portions which are secured together. Sternlicht and Lubow disclose protective gloves having stitched seams. Allen discloses a container having rigidly sealed edges. Futo discloses blocks which are stacked to create a shield. None of these references disclose a flexible, moulded shield composed of a cylindrical shield body formed from a cured liquid silicone resin having a slit extending at an oblique angle relative to the radius of the shield body, wherein the slit is unsealed along its length to facilitate the passage of the source therethrough. Rather, the teaching references disclose a variety of sealed structures, none of which are adapted for ready attachment to a source of  $\gamma$ - rays.

With the foregoing in mind, the outstanding rejection fails on all accounts to establish a *prima facie* case of obviousness. First, the Examiner has failed to show some suggestion or motivation to modify the references or to combine the reference teachings. As discussed above, the teaching references are not analogous to the base references and provide no teaching or suggestion to modify the base references to read upon the pending claims. The Office Action further fails to show a reasonable expectation of success in modifying the primary references based upon the teachings of the prior art. The teaching references are once again not analogous to the primary

references and one would certainly not look to these references for modification related teachings.

In addition, the prior art fails to disclose all elements of the claimed invention; that is, a shield composed of a cylindrical body with an obliquely oriented, unsealed slit as claimed.

In an effort to support the rejection and the interpretation of the pending claims, the Examiner argues that the language relating to the unsealed nature of the slit should be given limited weight in distinguishing the claimed invention from the prior art. The Examiner states that “applicants’ claims do not recite the slit as remaining ‘unsealed’ at all times”. While this may be true, the prior art cited by the Examiner offers no suggestion for providing an unsealed, obliquely angled slit in a radiation shield such that the shield may be placed over a source of radiation, regardless of the fact of whether the slit is later sealed. The disclosures of Lubow, Sternlicht, Allen, Futo and Morrison all teach shields *per se* that must be sealed along their edges to function properly. Without sealed edges none of these references function, as there is nothing to hold them together.

The weakness of the outstanding rejection is demonstrated by the many references cited by the Examiner. Rather than citing the “best” prior art, the Examiner has cited seven references apparently with the hope that one of the combinations reads on Appellants’ invention. Despite this effort, no combination of references obviates the claimed invention.

With the foregoing in mind, it is Appellants’ opinion the rejection of claim 20 is improper. Appellants, therefore, respectfully request that the rejection of claim 20 be reversed. As to those claims dependent upon claim 20, they are believed to be improper for the reasons presented above with regard to independent claim 20 and Appellants similarly request that the rejections relating to these claims be reversed.

II. **CLAIMS 20-26 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103(a) BASED UPON THE DISCLOSURE OF SEDLAK OR BRETON OR WEINBERGER IN VIEW OF LUBOW, STERNLICHT, ALLEN, FUTO OR MORRISON AND FURTHER IN VIEW OF HARRISON AND COTE, FRY OR McCLINTOCK.**

Harrison, Cote, Fry and McClintock have been presented as teaching the obviousness of wrapping sheet material around a pipe such that the cut ends abut each other when the sheet is wrapped around the pipe. In fact, the Examiner notes in the Office Action of December 26, 2001, that “it is a notoriously well known expedient that in forming a shielding type material for around a pipe, to form said shielding type material into a tubular shape with a longitudinal slit to facilitate mounting to the pipe, as evidenced for example by the teachings thereof in any of the secondary references of Cote, Fry et al. or McClintock and to so modify any of the primary references would accordingly have been prime facie obvious”.

As such, Harrison, Cote, Fry and McClintock are directed to issues other than the utilization of an obliquely angled, unsealed slit in a cylindrical radiation shielding device as claimed and none address the deficiencies found in Lubow, Sternlicht, Allen, Futo or Morrison in modifying Sedlak or Breton or Weinberger. In particular, neither Harrison, Cote, Fry nor McClintock disclose or suggest the obviousness of modifying Sedlak or Breton or Weinberger with a cylindrical body having an obliquely angled, unsealed slit for minimizing shine penetrating through the shield material.

In fact, it is Appellants’ opinion that the citation of such tubular shields as those disclosed by Harrison, Cote, Fry and McClintock ultimately supports Appellants’ contention of nonobviousness. Specifically, if the claimed obliquely angled, unsealed slit within a moulded radiation shield asserted as being obvious by the Examiner where in fact obvious, would not a prior art reference similar to Harrison, Cote, Fry or McClintock be available which discloses an obliquely angled, unsealed slit in a

tubular shield. Rather, the modification is not in fact obvious and the Examiner has chosen to improperly combine a variety of nonanalogous references based upon a hindsight analysis of the claimed invention.

As such, and further to the reasons presented above in Section I, it is Appellants' opinion that claim 20 overcomes the prior art of record and Appellants respectfully request that the rejection under 35 U.S.C. § 103(a) be reversed. As to those claims dependent upon independent claim 20, they are also believed to overcome the prior art of record and Appellants similarly request that the rejection of these dependent claims be reversed.

**III. CLAIM 20-26 ARE NOT OBVIOUS UNDER 35 U.S.C. § 103(a) BASED UPON THE DISCLOSURE OF SEDLAK OR BRETON OR WEINBERGER IN VIEW OF LUBOW, STERNLICHT, ALLEN, FUTO OR MORRISON AND FURTHER IN VIEW OF FREVEL, LABINO, THE '799 PATENT OR TARLOW.**

Frevel, Labino, the '799 patent and Tarlow have been cited in addition to the rejection presented above in Section I. Presumably, and with reference to the Office Action of June 17, 2002, these references are cited as showing "that it is old and advantageous and hence obvious to wrap around the pipe carrying radioactive material, radiation shielding material in sheet form". Further, and with reference to the Office Action of June 17, 2002, the Examiner states "it is conventionally known to utilize radiation shielding for pipes carrying a radiation emitting source and it would have been obvious on its face to so utilize the radiation shielding of any of the primary references. In any event, such would have been obvious in view of the teachings thereof in any of Frevel, Labino or Japan 0052799".

Appellants do not contest that it is known to wrap shielding material around radiation carrying pipes, however, and as with the prior art discussed above with regard to Sections I and II, nothing cited by the Examiner discloses or suggests the obviousness of providing the claimed shielding material with an obliquely angled, unsealed slit for positioning about a pipe carrying a source of radiation.

With this in mind, it is Appellants' opinion that claim 20 overcomes the prior art of record and the rejection under 35 U.S.C. §103(a) is improper. As such, Appellants respectfully request that the rejection there of be reversed. As to those claims dependent upon independent claim 20, they are also believed to overcome the prior art of record and Appellants similarly request that the rejection of these dependent claims be reversed.

**IV. CLAIMS 20 - 26 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, AS FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT, CLAIMS 20 - 26 ARE NOT UNPATENTABLE UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, FOR FAILING TO COMPLY WITH THE ENABLMENT REQUIREMENT AND CLAIMS 20 - 26 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §1 12, SECOND PARAGRAPH, AS BEING INDEFINITE FOR FAILING TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE SUBJECT MATTER WHICH APPLICANT REGARDS AS THE INVENTION.**

These three rejections are being addressed herein together as they all relate to claim language concerning the passage of a  $\gamma$ -radiation source (for example, a pipe through material emitting  $\gamma$ - rays is passing) through an unsealed slit and the support for such claim language in the original disclosure.

The original disclosure is very detailed in providing support for claiming that the "slit is unsealed along its length to facilitate the passage of the source therethrough". In particular, and

with reference to Page 3, lines 11-13, the specification states that the moulded shield is “adapted to surround a radiation source located in said cavity, said core layer being located between two outer layers of solid polymeric material”. Further, and with reference to Page 6, lines 18-22, it is stated that “the shield may be in the form of a tube 2 (Figure 1) with a longitudinal slit 4 and which because it is made of resilient material, can be opened along the slit so that it can be pushed over a length of pipe and then closed over the pipe, e.g. by the use of quick-locking plastic straps (not shown) of the well known kind such as used in ties in horticulture”. In addition, Page 7, lines 2-3 state “to reduce or eliminate shine, the slit is preferably so formed that when the tube is closed over the pipe, the protection provided by the tube is unbroken”.

With the foregoing in mind, and with reference to the various figures provided in conjunction with the application, it is inconceivable that one of ordinary skill in the art would not understand how “the slit is unsealed along its length to facilitate the passage of the source [for example, a pipe carrying a source of gamma rays] therethrough”. The specification as originally filed explains that the moulded shield along its slit is passed over a pipe so as to cover it. The drawings support this disclosure. The original disclosure says that the slit is flexible enough to fit about the pipe thereby enclosing it.

With this in mind, it is Appellants’ opinion that the specification is enabling of the claimed structure, in compliance with the written description requirement as it relates to the claimed structure and distinctly claims and points out the subject matter of the invention. While the language utilized in the claims may not be exactly that which is utilized in the specification, one of ordinary skill in the art would certainly appreciate the meaning of this language, understand where in the specification it is described and understand how to make and use such a moulded shield.

With this in mind, Appellants respectfully request that all of the rejections under 35 U.S.C. § 112 be reversed.

## **XII. CONCLUSION**

In conclusion, Appellants have now shown that the references cited in the Office Action neither disclose nor suggest the claimed shield. In addition, Appellants have now shown that the claims and specification are in compliance with § 112. Therefore, it is respectfully requested that the outstanding rejections of claims 20-26 be reversed.

Respectfully submitted,



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## APPENDIX

### CLAIMS ON APPEAL

20. A moulded shield for a source of  $\gamma$ -rays, comprising:

    a cylindrical shield body having a cavity shaped and dimensioned to receive the source, the shield body being in the form of a tube with an inner face, an outer face and a longitudinal slit for fitting over a pipe so as to permit the passage of the source into the cavity, the slit extending from the inner face to the outer face at an oblique angle relative to the radius of the shield body and the slit is unsealed along its length to facilitate the passage of the source therethrough;

    the shield body including a core layer of cured liquid silicone resin loaded with particulate  $\gamma$  radiation-shielding material adapted to surround a radiation source located in the cavity, the core layer being located between two outer layers of solid polymeric material.

21. The shield according to claim 20, wherein the particulate radiation shielding material comprises lead particles.

22. The shield according to claim 20, wherein the core is encapsulated in the solid polymeric material.

23. The shield according to claim 20, wherein the solid polymeric material comprises cured liquid resin.

24. The shield according to claim 23, wherein the solid polymeric material comprises silicone.
25. The shield according to claim 20, wherein the outer layers are each 0.5 to 3mm thick.
26. The shield according to claim 20, wherein the core layer is 5 to 50mm thick.